



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

HIGHFIELD et al

Serial No. **09/664,363**

Filed: **September 18, 2000**

For: **VIRAL AGENT**

Atty. Ref.: **2035-38**

Group: **1648**

Examiner: **Li, B.**

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March 4, 2002

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

RENEWED PETITION UNDER RULE 181

For the reasons described below, Applicants request reconsideration of the decision dated January 3, 2002, on the Alternative Petition Under Rule 181 filed September 20, 2001. The Commissioner is again requested to invoke his supervisory authority and have the Restriction Requirement of April 20, 2001 (Paper Number 4) restated (reformulated), the Examiner having refused to do the same in the Office Action dated November 27, 2001 (Paper Number 7).

The following is a statement of facts, as required by Rule 181(b), and point or points to be reviewed and the action requested.

The Examiner has taken the position that restriction to a single sequence is required as each sequence within the scope of Groups I and III-VIII represents a separate invention. The requirement here clearly places a monumental burden on

Applicants in terms of potential filing and prosecution costs associated with divisional applications.

Paramount to the considerations of the policy set forth in the Notice of November 19, 1996 was the balance that the Commissioner endeavored to establish between aiding the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office. The Commissioner determined that the most appropriate way to strike that balance was to permit consideration of a "reasonable number" of sequences in a single application.

It is respectfully submitted that the fact that claims may be presented that define a claimed nucleic acid sequence in terms of an encoded protein should not preclude the application of the approach articulated in the Notice.

The clear spirit of the Notice is that of balancing the burden borne by the Office and by an applicant. This is apparent particularly from the Examples set forth in the Notice. Example (1), for instance, relates to "an isolated and purified DNA fragment comprising DNA having at least 95% identity to a DNA sequence selected from SEQ ID Nos. 1-1,000". The Notice indicates that ten (10) nucleotide sequences could be selected in response to a restriction requirement and any other claimed sequences which are patentably indistinct therefrom would be examined. This Example serves signify the type of burden that the Commissioner believes should be borne by the Office and it is submitted that the position taken by the Examiner in the present case is inconsistent therewith.

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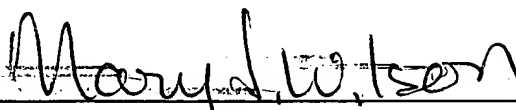
The Commissioner is again requested to invoke his supervisory authority and withdraw the Restriction Requirement of April 20, 2001 and have the Restriction Requirement restated in a new Office Action (allowing at least examination of sequences (a)-(h)).

Authorization is hereby given to charge any missing or deficient fees to our Deposit Account No. 14-1140 (2035-38) and proceed to consider this Petition.

Grant of the present Renewed Petition is requested.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: 
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In re Application of

UNITED STATES PATENT AND TRADEMARK OFFICE

Atty Dkt. 2035-38

C# M#

HIGHFIELD et al

MAR 04 2002

Group Art Unit: 1648

Serial No. 09/664,363

Examiner: Li, B.

Filed: September 18, 2000

Date: March 4, 2002

Title: VIRAL AGENT

Assistant Commissioner for Patents
Washington, DC 20231

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Sir:

RENEWED PETITION

This is a response/amendment/letter in the above-identified application and includes an attachment which is hereby incorporated by reference and the signature below serves as the signature to the attachment in the absence of any other signature thereon.

Fees are attached as calculated below:

Total effective claims after amendment	0	minus highest number		
previously paid for	20	(at least 20) =	0 x \$ 18.00	\$ 0.00

Independent claims after amendment	0	minus highest number		
previously paid for	3	(at least 3) =	0 x \$ 84.00	\$ 0.00

If proper multiple dependent claims now added for first time, add \$280.00 (ignore improper)	\$ 0.00
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Petition is hereby made to extend the current due date so as to cover the filing date of this paper and attachment(s) (\$110.00/1 month; \$400.00/2 months; \$920.00/3 months)	\$ 0.00
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Terminal disclaimer enclosed, add \$ 110.00	\$ 0.00
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<input type="checkbox"/> First/second submission after Final Rejection pursuant to 37 CFR 1.129(a) (\$740.00)	\$ 0.00
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☐ Please enter the previously unentered, filed

☐ Submission attached

Subtotal \$ 0.00

If "small entity," then enter half (1/2) of subtotal and subtract	-\$ 0.00
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☐ Applicant claims "small entity" status. ☐ Statement filed herewith

Rule 56 Information Disclosure Statement Filing Fee (\$180.00)	\$ 0.00
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Assignment Recording Fee (\$40.00)	\$ 0.00
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Other:	0.00
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TOTAL FEE ENCLOSED \$ 0.00

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140. A duplicate copy of this sheet is attached.

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By Atty: Mary J. Wilson, Reg. No. 32,955

Signature: Mary J. Wilson